

For convenient reference, the pertinent part of the Office Action is set forth below, with comments interlineated.

[Page 2]DETAILED ACTION

*Election/Restrictions*

*Restriction to one of the following inventions is required under 35 U.S.C. 121:*

*i.*

*Claims 1-3, 11, and 20, to the extent that the invention is drawn to a method for obtaining signature probes, classified in class 536, subclass 25.1*

*ii. Claims 4-10, 19 and 20, to the extent that the invention is drawn to a method of determining genetic affinity of organisms or viruses in a test sample, classified in class 435, subclass 536. If this group is elected, then the below summarized specie election is also required.*

Group II, Claims 4-10 and 19-20, is hereby elected with traverse, and Claim 20 is amended to link the remaining claims. If the requirement is maintained, the right to file the remaining claims in a divisional application is reserved.

*iii.*

*Claim 12 and 20, to the extent that the invention is drawn to an isolated nucleic acid sequence, classified in class 536, subclass 1. If this group is elected then the below summarized sequence election is also required.*

*iv.*

*Claim 13 and 20, to the extent that the invention is drawn to a nucleic acid sequence with a strong affinity to Legionella nautilum, classified in class 536, subclass 24.32.*

*v.*

*Claim 14 and 20, to the extent that the invention is drawn to a nucleic acid sequence with a strong affinity to Listeria gray, classified in class 536, subclass 24.32.*

*vi.*

*15 and 20, to the extent that the invention is drawn to a nucleic acid sequence for identifying organisms from the group of Borrelia,*

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*Brachyspira, Spirochaeta, and Treponema, classified in class 536, subclass 24.32.*

*vii.*

*Claim 16 and 20, to the extent that the invention is drawn to a nucleic acid sequence with a strong affinity to Ureaplasma canigenitalium, classified in class 536, subclass 24.32.*

*viii.*

*Claim 17 and 20, to the extent that the invention is drawn to nucleic acid sequences that are a perfect signature for node 4254, classified in class 536, subclass 24.32. If this group is elected then the below summarized sequence election is also required.*

*ix.*

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*Claim 18 and 20, to the extent that the invention is drawn to an assay or test kit, classified in class 435, subclass 6.*

*The inventions are distinct, each from the other because of the following reasons:*

*Inventions I, II, III, IV, V, VI, VII, VIII, and IX are directed to related methods for obtaining signature probes and determining affinities. The related inventions are distinctive if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.050). In the instant case, the different inventions have different modes of operation, different structures, and different functions.*

*[Application/Control Number: 10/057,270 Art Unit: 1631Page 4] Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.*

*Election of Species regarding Group I/*

*This application contains claims directed to the following patentably distinct species for generating a tree of relationships of the claimed invention: species of parsimony, distance, and maximum likelihood methods.*

*Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 4-10, 19, and 20 is generic with respect to generating a tree of relationships.*

*Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.*

*Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a)*

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*Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.*

Having provisionally elected Group II, Applicants respectfully traverse this requirement for election of species. If this requirement is maintained, then

Applicants provisionally elect the species of provisionally withdrawn Claim 13:

The RNA sequence CUGUAGAGAUGA or the corresponding DNA sequence, and probes complementary to any of the foregoing or to sequences containing any of the

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foregoing, which are valuable for identification of samples containing organisms with strong genetic affinity to *Legionella nautarum*.

*Sequence Election Requirement*

*In addition, each Group III and VIII detailed above reads on patentably distinct sequences. Each sequence is patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For an elected Group drawn to amino acid sequences, the Applicants must elect a single amino acid sequence. For an elected Group drawn to nucleotide sequences, the Applicants must elect one nucleic acid sequence.*

*Examination will be restricted to only the elected sequences.*

*Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).*

*Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).*

*[Application/Control Number: 10/057,270 Art Unit: 1631Page 6] This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR*

*§§1.821 (a)(1) and (a)(2). See, for example, table B in the specification on page 45. However, this application fails to comply with the requirements of 37 CFR §§ 1.821 through 1.825 because it lacks any submission of a computer readable form sequence listing, a paper copy for the specification, a statements under 37 CFR §§ 1.821 (f) and (g), and SEQ ID Nos cited along with each sequence in the specification or Figures. Applicants are also reminded that SEQ ID Nos are not required in Figures per se, however, the corresponding SEQ ID Nos then are required in the Brief Description of the Drawings section in the specification. Applicants are also reminded that a CD-ROM sequence listing submission may replace the paper and computer readable form sequence listing copies. Applicant(s) are given the same response time regarding this failure to comply as that set forth to respond to this office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.*

*Linking Claims*

*Claim 20 link(s) inventions I-IX. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 20. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or [Application/Control Number: 10/057,270 Art Unit: 1631Page 7] including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler,*

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44F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

**Conclusion**

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Sims, whose telephone number is (571)-272-7540.*

*If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ardin Marscher can be reached via telephone 1-571-272-0718.*

*Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The Central PTO Fax Center number is 1.571.273.8300.*

*Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is 1.571.272.0549.*

*Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 800-277-0197 (toll-free).*

Any necessary (small entity) charges can be charged to USPTO Deposit Account 20-336 of Technology Licensing Co. LLC. Correspondence may be addressed to Customer No. 26830.

The Examiner is especially invited to suggest allowable subject matter on next action, and to telephone Applicants' Attorney if that would expedite commencement of prosecution and disposal of this Application.

Respectfully submitted,

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